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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,445	08/16/2001	Timothy J. Griswold	A7807	4414
23838	7590	03/24/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			YUAN, ALMARI ROMERO	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

412

Office Action Summary	Application No. 09/930,445	Applicant(s) GRISWOLD ET AL.	
	Examiner Almari Yuan	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 10-17, 39-46 and 69-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 18-38, 47-68 and 77-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on 08/16/01, IDS filed on 12/21/01, and Response to Restriction Requirement filed on 1/18/05.
2. Claims 10-17, 39-46, and 69-76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions.
3. Claims 1-9, 18-38, 47-68, and 77-89 are pending. Claims 1, 30, 59, and 60 are independent claims.

Election/Restrictions

4. Applicant's election without traverse of claims 1-9, 18-38, 47-68, and 77-89 in the reply filed on 1/18/05 is acknowledged.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 12/21/01 has been considered by the Examiner.

Specification

6. The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable code. For example, on page 3, line 2; on page 10, lines 1-4; on page 11, line 6; on page 21, lines 6-10; on page 22, lines 20-21; on page 23, lines 1-3 and line 20; on page 27, line 17; on page 29, lines 8-11; on page 31, line 18; on page 32, lines 2-3 and line 8; on page 33, lines 20-21; on page 34, lines 2-6 and line 15; on

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page 35, lines 6-13; and on page 36, lines 4-5. Applicant is suggested to add left and right brackets or quotation marks on each side of hyperlink to deactivate hyperlink or Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

7. Applicant is advised that should claims 30 and 59 be found allowable, claim 59 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1-9, 20-38, 49-68, and 79-89 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilboy (USPN 6,829,233 B1 – filed 07/2000).**

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Regarding independent claim 30 and (claims 1, 59, and 60), Gilboy discloses:

Accessing Internet addresses based on a request from a wireless device (see Abstract), comprising:

a database storing relationships between a short-name and an internet address, said short-name comprising a code number representative of a particular internet address, said database being located at a location remote from said wireless device (see Figures 3-5, col. 4, lines 1-19 teaches databases comprising table with stored telephone numbers with its corresponding stored URLs; wherein the databases 20, 22, and 24 are coupled to server 18); and

a controller which receives a transmitted short-name from said wireless device (on col. 3, lines 26-30 teaches receiving dialed number from the subscriber), said controller operable to search said database for said transmitted short-name is found, retrieving said particular internet address so that said wireless device can be connected to said particular internet address (on col. 4, lines 1-19 teaches the ITSP server searches CPN, DN, and Default databases to match the dialed telephone number with its corresponding URL address; on col. 3, lines 48-54 teaches displaying targeted visual content associated with the retrieved URL address).

Regarding dependent claims 2, 31, and 61, Gilboy discloses:

database is accessed over the internet (see Figure 1 items 20, 22, and 24).

Regarding dependent claims 3, 32, and 62, Gilboy discloses:

database is accessed through a wireless service provider without traversing the internet (see Figure 1, item 28).

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Regarding dependent claims 4, 33, and 63, Gilboy discloses:

short-name is received by a software application that queries said database (on col. 4, lines 1-19 teaches searching database).

Regarding dependent claims 5, 34, and 64, Gilboy discloses:

at least one of said software application and said database maps said short-name to an internet URL (on col. 4, lines 1-19 teaches matching telephone number with its corresponding URL address).

Regarding dependent claims 6, 35, and 65, Gilboy discloses:

wherein multiple short-names can map to a single internet address (See Figure 5 shows DN=732, 201, 908 corresponds to “www.news.com/loc=NJ”).

Regarding dependent claims 7, 36, and 66, Gilboy discloses:

identifying a transport protocol required to complete said accessing; and addressing a sending site in accordance with said transport protocol (on col. 2, lines 48-65 teaches using Internet Protocol (IP) addresses to connect into the network).

Regarding dependent claims 8, 37, and 67, Gilboy discloses:

if said database indicates that said short-name is not found, searching a second database for said short-name (on col. 4, lines 1-19 teaches searching plurality of databases 20, 22, 24)).

Regarding dependent claims 9, 38, and 68, Gilboy discloses:

a plurality of databases, said databases arranged in a logical hierarchy so that if said short-name is not found in a first database, said searching is resubmitted to a next database in said hierarchy (see Figure 1, databases 20, 22, and 24 and on col. 14, lines 1-19 teaches searching databases).

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Regarding dependent claims 20, 49, and 79, Gilboy discloses:

short name corresponds to a phone number in E.164 format (See Figure 3 item 202 and Figure 4 item 302).

Regarding dependent claims 21, 50, and 80, Gilboy discloses:

short name corresponds to a phone number (See Figures 3-5 shows phone numbers).

Regarding dependent claims 22, 51, and 81, Gilboy discloses:

short name further comprises a root short-name, a separator code, and an extension, said separator code separating said root short name from said extension (see Figure 3 item 202, Figure 4, item 302, and Figure 5, item 402).

Regarding dependent claims 23, 52, and 82, Gilboy discloses:

said root short name corresponds to a said particular address and said extension corresponds to a sub-address of said particular address (See Figure 3 shows a telephone number can correspond to a plurality of URL addresses).

Regarding dependent claims 24, 53, and 83, Gilboy discloses:

short name comprises multiple separator codes and multiple extensions (See Figures 3-5).

Regarding dependent claims 25, 54, and 84, Gilboy discloses:

extension corresponds to a particular country (see Figure 3 item 202, Figure 4, item 302, and Figure 5, item 402 shows country codes).

Regarding dependent claims 26, 55, and 85, Gilboy discloses:

extension corresponds to an ITU country code (see Figure 3 item 202, Figure 4, item 302, and Figure 5, item 402 shows country codes such as 732, 908, 412).

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Regarding dependent claims 27, 56, and 86, Gilboy discloses:

short name comprises in order, a country code indicator sequence, a country code, and separator code, and a root short name (see Figure 3 item 202 and Figure 4, item 302).

Regarding dependent claims 28, 57, and 87, Gilboy discloses:

extension comprises variable data that is entered into a website corresponding to said root short name (See Figure 5 item 402 that matches with Content 404).

Regarding dependent claims 29, 58, and 88, Gilboy discloses:

extension corresponds to variable data that is entered into a website corresponding to said root short name (See Figure 5 item 402 that matches with Content 404) extension corresponds to a particular country (see Figure 3 item 202, Figure 4, item 302, and Figure 5, item 402 shows country codes).

Regarding dependent claim 89, Gilboy discloses:

short name is registered with a central authority for the internet (see Abstract).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 18-19, 47-48, and 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboy, as applied to claims 1, 30, and 60 above, in view of Jones et al. (USPN 6,141,341 – filed 9/1998).**

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Regarding dependent claims 18-19, 47-48, and 77-78, Gilboy discloses the invention substantially as claimed as described above, however, Gilboy does not explicitly disclose “short-name is input to said wireless device in the form of voice command, and said voice command is converted to a non-voice command after being transmitted by said wireless device”.

Jones teaches signals representative of a telephone number; wherein the signals can be analog signals (voice) to be converted into digital signals at the digital wireless handset and transmitted to a network premises gateway (on col. 10, lines 7-34)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Jones into Gilboy to provide analog signals (voice) which can be a telephone number to be converted into digital signals, as taught by Jones, into the wireless environment of Gilboy, in order to reduce the cost and complexity in a Internet protocol telephone system.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,687,242 B1 – Enzmann et al. – filed on 12/1999

USPN 6,842,612 B2 – Kalish et al. – filed 12/2000

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 571-272-4104.

The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY
March 18, 2005


SANJAY SHAH
PRIMARY EXAMINER